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FILE: CADL:002

November 21, 2000

**CERTIFICATE OF MAILING**  
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on the date below:

November 21, 2000  
Date

Steven L. Highlander

**BOX AF**

Assistant Commissioner for Patents  
Washington, DC 20231

RE: *SN 07/431,533 "URINARY TUMOR ASSOCIATED ANTIGEN, ANTIGENIC SUBUNITS AND METHODS OF DETECTION" – By Donald Morton et al.*

Sir:

Enclosed for filing in the above-referenced patent application is:

- (1) Request Under 37 C.F.R. §1.193(b)(2)(ii) to Proceed on Appeal;
- (2) Supplemental Brief Under 37 C.F.R. §1.193(b)(2)(ii) an original and two copies);
- (3) A check in the amount of \$195.00 for a two-month extension of time; and
- (4) A return postcard to acknowledge receipt of these materials. Please date stamp and mail this postcard.

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Assistant Commissioner for Patents

November 20, 2000

Page 2

A fee as set forth in 37 C.F.R. §§1.16-1.21 in the amount of \$195.00 is enclosed herewith. If an appropriate check has been enclosed, or if it is insufficient under 37 C.F.R. §§1.116 to 1.21, the Commissioner is hereby authorized to deduct any necessary fees from Fulbright & Jaworski Deposit Account No. 50-1212/10005391/SLH.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "SLH", enclosed within a circular scribble.

Steven L. Highlander  
Reg. No. 37,642

SLH/cpj  
Encl:

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Donald L. Morton,  
Rishab K. Gupta and  
David M. Euhus



Serial No.: 07/431,533

Filed: November 3, 1989

For: URINARY TUMOR ASSOCIATED  
ANTIGEN, ANTIGENIC SUBUNITS  
AND METHODS OF DETECTION

Group Art Unit: 1642

Examiner: M. Davis

Atty. Dkt. No.: CADL:002/SLH

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November 21, 2000  
Date

Steven L. Highlander

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**REQUEST UNDER 37 C.F.R. §1.193(b)(2)(ii) TO PROCEED ON APPEAL**

BOX AF

Hon. Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

This is a request to proceed with the appeal for the above-captioned application, the appeal having been terminated by the examiner's reopening of prosecution. The salient facts are as follows:

On November 3, 1989, applicants filed the instant application. On June 13, 1997, applicants filed a Notice of Appeal for the above-captioned application. On August 18, 1997, applicants filed a Brief on Appeal. On November 4, 1997, the examiner issued a non-final

Office Action in which prosecution on the merits was reopened. In the action, the examiner withdrew rejections under 35 U.S.C. §102 and §103. In addition, the examiner posed nine new grounds of rejection, including one previously withdrawn.

In the hopes that the reopened prosecution would lead to progress towards allowance, applicant readily accepted this new action. However, since that time, no meaningful progress has been made despite numerous submission on applicant's behalf. Moreover, the present non-final action appears to be nothing more than a rearrangement of previous references into what amounts to the same rejections.

The PTO has a policy against "piece-meal" prosecution. Examiners are expected raise all valid rejections at the same time to expedite prosecution rather than posing rejections seriatim. Clearly, this policy has not been adhered to in this case. Applicant realizes that multiple examiners have been involved but, nonetheless, it is unfair to delay the prosecution in this matter when the PTO has had an ample opportunity to raise each of the new rejections now advanced.

Moreover, applicant has incurred considerable expense, both in government fees and attorney costs, in placing this application on appeal *twice*. Quite possibly, applicant will be forced to again proceed with an appeal, at which time the examiner may decide to reopen prosecution yet another time, further adding to the expense. The possibility of this vicious circle must be eliminated. A supplemental appeal brief is attached.

Thus, applicants respectfully request, in the interest of conserving time, applicant's finances and the PTO's resources, that the examiner be forced to raise these new rejections in the context of the appeal. Should any interested person believe that further discussion of this matter is required, a call to the undersigned at the telephone number listed below is invited.

No fees are believed due in connection with this petition. However, should any fees be due, applicant authorizes the Assistant Commissioner to debit Fulbright & Jaworski Deposit Acct. No. 50-1212/10005391/SLH.

Respectfully submitted,

Steven L. Highlander  
Reg. No. 37,642  
Attorney for Applicant

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Date: November 21, 2000